

Remarks

Status of the Claims

Claims 1-60 are pending in the application. All claims stand rejected. By this paper, claims 1, 3-5, 9-15, 20-27, 29, 31-41, 49-52, and 59-60 have been amended. Claims 16-19, 30, and 48 have been cancelled. For the reasons set forth below, Applicant submits that each of the remaining pending claims is patentably distinct from the cited prior art and in condition for allowance. Reconsideration of the claims is therefore respectfully requested.

Claim Objections

Claim 15 was amended to read "new contact from a list stored," as suggested by the Examiner. Likewise, claim 59 was properly labeled in sequence between claim 58 and 60. These amendments are believed to overcome the Office Action's objections.

Claim Rejections - 35 U.S.C. § 112

Claim 25 stands rejected as being indefinite. Applicant has amended claim 25 to read "[t]he system of claim 20, wherein the set top box further comprises:

a microphone to capture the user's voice; and

a speaker to generate audible output from a second audio signal."

This amendment is believed to overcome the § 112 rejection because the set top box no longer recites transmitting an audio signal to itself.

Claim Rejections – 35 U.S.C. §§ 102, 103(a)

Claims 1-7, 10-12, 16-17, 19-35, 38-44, 47-49, 53-54 and 56-60 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,671,267 issued to August et al. ("August").

Claims 8, 13-15, 45 and 50-52 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over August in view of Official Notice. Claims 9 and 46 are rejected under § 103(a) as being unpatentable over August in view of U.S. Patent No. 6,240,303 issued to Katzur. Claims 18 and 55 are rejected under § 103(a) as being unpatentable over August in view of U.S. Patent No. 6,832,083 to Oba et al. ("Oba"). Claims 36-37 are rejected under § 103(a) as being unpatentable over August in view of U.S. Patent No. 6,339,842 to Fernandez et al. ("Fernandez"). As set forth below, Applicant respectfully submits that each of the pending claims is patentably distinct from the cited references, individually and collectively.

Neither August nor Oba Teaches or Suggests a Selectable List of Pictures Representing At Least a Portion of a List of Contacts on a Remote Control of An Interactive Television System

Claim 1 has been amended to include the limitations of claim 18, now canceled. As amended, claim 1 recites a remote control device for an interactive television system, comprising

a memory to store a list of contacts, each contact being represented by an address for establishing communication with the contact via the interactive television system and a picture for selecting the contact;

a display device to display at least a portion of the pictures representing contacts;

a plurality of user controls to receive a user selection of a picture representing a particular contact from the list, the user controls further being to remotely operate the interactive television system; and

a wireless transmitter to transmit the address corresponding to the selected contact to the interactive television system to initiate communication between a user and the selected contact.

August does not teach all of the limitations of claim 1. Indeed, with reference to cancelled claim 18, the Office Action conceded that August does not teach "that the identifiers comprise a picture of the contact." However, the addition of Oda does not cure the deficiencies of August.

The Office Action cites to Figure 26 of Oba, which shows a process whereby a user of a multiuser communication device, after initiation of a telephone conversation, may decide to display a self-image for view by the other person with whom the user is communicating. Col. 14, lines 36-58. This is nothing more than video conferencing with the option of letting the other person with whom a user communicates view the user's pre-stored self-image in lieu of a current image.

By contrast, claim 1 is not referring to a video conferencing image. Claim 1 recites a contact list in a remote control that uses a picture representing each contact to be displayed in the list, which, when selected, initiates communication between the user and the contact by transmitting the contact's address to the interactive television system. It is clear that the picture is viewable before the initiation of the conversation, and does not act as a self-image of the contact with whom the user is currently communicating, i.e. the picture is not sent to the contact – indeed, the picture is of the contact.

Additionally, the person responding to the initiated conversation of claim 1 could be the roommate or spouse of the contact that the user intends to speak with. In contrast, Oba teaches always displaying a self-image of the other person with whom the user initiates a phone conversation when video is sent along with audio, Col. 14, lines 36-41, making distinctly clear that the person with whom a user makes contact is the person of the self-image. Therefore, Oba is concerned with the identity of the person sending video content in response to the initiation of a video conference call. See also Col. 1, lines 37-39.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03. Because neither August nor Oba does teach or suggest, *inter alia*, a selectable list of pictures representing at least a portion of a list of contacts on a remote control of an interactive television system, the Office Action fails to establish a prima facie case of obviousness.

The applicant respectfully submits, therefore, that claim 1, as amended, is patentably distinct over the cited references. Claim 59 has been amended to include similar limitations and is likewise believed to be patentably distinct for at least the same reasons. Claims 2-15 are also patentably distinct by virtue of their dependence from claim 1.

August Does Not Teach or Suggest A Noise Cancellation Component to Cancel TV Output from the Captured First Audio Signal and Pass the User's Voice

As amended, claim 20 recites a system for providing two-way communication using an interactive television system, comprising:

a remote control to control operation of the interactive television system, the remote control further comprising a plurality of user controls to receive a user selection of a contact from a list of contacts, each contact having an associated address for establishing two-way communication with the contact, the remote control further comprising a wireless transmitter to transmit the address corresponding to the selected contact;

a set top box having a wireless receiver for receiving the address corresponding to the selected contact from the remote control, the set top box to establish two-way communication with the selected contact via the interactive television system; and

an output device for generating television output, wherein the remote control comprises an input device for capturing a first audio signal including a user's voice and the television output, and wherein the set top box comprises a noise cancellation component to cancel the television output from the captured first audio signal and pass the user's voice.

The added limitations are incorporated from dependent claim 39.

The Office Action cites to column 9, lines 7-22 of August for support of "wherein the set top box comprises a noise cancellation component to cancel the audible output from the captured audio signal." Page 7. As amended, the television output replaces the previously cited "audible" output. This passage of August, however, teaches only a process step by which a user decides whether to mute a remotely operated device (i.e. a TV), or to reduce the sound output to a predetermined level ("muffling"), to facilitate a user's communication on a handset unit.

By contrast, claim 20 does not mute the television output, but allows the television output to continue unaltered. The television output, instead, is treated as noise that may be filtered out or "cancelled," thereby allowing a user's voice to pass through the interactive television system. This is accomplished through capturing the TV audio output with the user's voice with an input device of the remote control, and after transmitting it to the set top box (STB), the STB cancels the unwanted television output. Page 36, lines 10-22.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131.01. Because August does not teach or suggest at least "wherein the set top box comprises a noise cancellation component to cancel the television output from the captured first audio signal and pass the user's voice," the applicant respectfully submits that claim 20 is patentably distinct over August. Claim 39 is of similar scope and is believed be likewise patentably distinct over August. Claims 21-28, as amended, are also patentably distinct by virtue of their dependency from claim 20.

August Does Not Teach or Suggest a Contact Entry Component to Receiver User Selections of New Contacts to be Entered into the List of Contacts

As amended, claim 29 recites a system for providing two-way communication using an interactive television system, the system comprising:

a remote control to control operation of the interactive television system, the remote control comprising a storage component to store a list of contacts, each contact having an associated address for establishing communication with the contact via the Interactive television system; a display component to display at least a portion of the list of contacts; a user selection component to

receive a user selection of a contact from the list; a transmission component to transmit the address corresponding to the selected contact to the interactive television system to initiate communication between a user and the selected contact; and a contact entry component to receive user selections of new contacts to be entered into the list of contacts.

The added limitation has been imported from cancelled claim 30.

Claim 30 was rejected as unpatentable under § 102 over August. The Office Action cited to column 7, lines 63-65. This passage from August, however, teaches that "[t]he key pad 360 is used to enter telephone number digits during dialing and programming of a repertory dialer memory, for example." Thus, August teaches programming a dialer memory by entering the digits manually into the phone.

In contrast, claim 29 recites "a contact entry component to receive user selections of new contacts to be entered into the list of contacts." Support for this may be found at least at page 18, starting at line 4:

In alternative embodiments, the 'Add' button 226 may be used to enter a contact selection mode in which the user may select a contact from a list (not shown), which may be retrieved from a remote telephone directory or contact list via the broadband communication network 101 or the Internet 112.

The same paragraph likewise discusses using the arrow buttons of the remote to move to a contact selection and highlight the selection before pressing the "Add" button 226 to add the contact to the list. It is clear that the simplified step of selecting a contact from a list to add the contact to a stored list of contacts is not the same as manually entering a contact's information, i.e. name and telephone number, character by character into a contact list. Likewise, August's discussion of a "directory of stored numbers" is limited to a few lines of the reference; there is no suggestion of inputting contacts into a contact list in any manner other than manually.

Because August does not teach or suggest "a contact entry component to receive user selections of new contacts to be entered into the list of contacts," the Applicant respectfully submits that claim 29 is patentably distinct over August. Claims 41 and 59 were amended to include the same limitation, and are likewise believed to be patentably distinct for at least the same reasons. Claims 31-40, 42-47, and 49-58 are also patentably distinct by virtue of their dependency from claims 29 and 41.

Claim 8

Claim 8 recites the "remote control of claim 7, wherein the network address designates a second interactive television system." The Office Action cites August as support for use of Official Notice that the "portable unit advantageously combines controlling the information provided by a remotely operated device in response to voice and data communications occurring over the telephone network." Col. 1, lines 41-44 (emphasis added).

However, August's focus, as indicated by the title, is an interactive system for communications between a cordless telephone and a remotely operated device. It is the integration of control in the cordless telephone that is taught, and any control of information provided by a telephone network is in response to voice and data communications, not to control communication passing both directions. Additionally, with millions of consumers, the odds are that most communication will be between contacts of disparate communication capabilities.

Claims 13-15 and 50-52

Claims 13-15 have been amended to depend from claim 10, which contains limitations imported into claim 29. For at least the reasons argued with respect to claim 29, claims 13-15 are also believed to be patentably distinct. That is, August does not teach or suggest "a contact entry component to receive a user selection of a new contact to be entered into the list of contacts," and claims 13-15 each add a further limitation of ways in which a new contact can be added.

#Claim 13, as amended, recites "wherein the user controls are to select a contact from a list being displayed by the interactive television system as the new contact." Figure 5 of August displays "Mom" and Mom's phone number, but this is not a list of contacts, but a caller identification function to indicate that "Mom" has called into the system. Because this is not a list displayed that contains contacts that a user may select to add to a list of contacts, August does not teach or suggest the limitation of claim 13.

#Claim 14, as amended, recites "wherein at least one user control is to select a contact from a list of contacts with whom the user has previously communicated as the new contact." Applicant teaches using a calling history from which to select a contact to add to the list of contacts. Page 18, lines 16-19. In addition, it is clear that Applicant's new contact is not a contact which was previously in the list of contacts. The Office Action, in contrast, seems to confuse selecting a contact to make a phone call with what claims 10 and 14 require – selecting a contact with whom the user has previously communicated to add that contact as a new contact, which August does not teach or suggest.

Claim 15, as amended, recites "wherein the user controls are to receive the new contact from a list stored in an external electronic device." The Office Action concedes August fails to disclose the reception of a new contact from a stored list, page 9, while pointing out that August teaches receiving a telephone number or identity of a call received through a set top box, an external device. See Col. 11, lines 48-55. Again, August is teaching a caller ID feature that may be passed on through a set top box to the cordless telephone, not providing a list of contacts stored on an external device from which a user can select a contact to add as a new contact to a list of contacts.

Claims 50-52 are of similar scope to claims 13-15. Applicant relies on the above discussion to likewise traverse the rejections of claims 50-52.

Conclusion

For at least the foregoing reasons, the cited prior art references, whether considered individually or in combination, fail to disclose each of the limitations in any of the pending independent claims. For at least the same reasons, each of the claims depending therefrom are also patentably distinct from the cited prior art. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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